

10/713,637  
END5240USNPRemarksStatus of Claims

Claims 1 and 5-30 were rejected. Claims 11, 12, and 28 have been amended. The amendments to the claims are being made merely to clarify the invention. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

§102 Rejections

In the Office Action dated 09/24/2007, claims 12-27 were rejected under 35 U.S.C. §102(b) as being unpatentable over Kovacs et al. (U.S. 5,833,603). Under MPEP 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference must be arranged as required by the claim. MPEP 2131 (emphasis added).

Applicant submits that Kovacs et al. fails to teach or suggest all of the limitations recited in amended independent claim 12, particularly in the arrangement required by the claim. For instance, amended independent claim 12 recites "determining whether cancerous tissue is present in the gastrointestinal tract of the patient." Kovacs et al. fails to teach or suggest such limitations, among others, particularly in the arrangement required by amended claim 12. Accordingly, Kovacs et al. fails to anticipate amended claim 12 in accordance with MPEP 2131. Applicant therefore respectfully requests that the rejection be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty.

§103 Rejections

Claims 1, 5-11, and 28-30 were rejected under 35 U.S.C. §103(a) as being obvious over Kovacs et al. in view of Iddan et al (U.S. 5,604,531) and Okada et al. (U.S. 5,424,546). Claims 12-27 were alternatively rejected under 35 U.S.C. §103(a) as being obvious over

10/713,637  
END5240USNP

Kovacs et al. Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01. *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembicza*k, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements*, standing alone, simply *are not evidence*. *Id.* Motivation to combine or modify will be lacking if the art teaches away from a claimed combination. MPEP 2145. For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of the present claims obvious.

Applicant submits that the art of record fails to teach or suggest all of the limitations recited in each independent claim in accordance with MPEP 2143.03. For instance, Applicant notes that independent claim 1 recites "first and second radiation detectors disposed at opposite ends of the capsule." These limitations, among others recited in claim 1, are neither taught nor suggested by the combined art of record. Indeed, the Office has explicitly conceded that the prior art fails to teach this limitation. See p. 5 of Office Action dated 09/24/2007. However, rather than acknowledging that the failure of the prior art to teach or suggest this structural limitation of claim 1 defeats the Office's obviousness position under MPEP 2143.03, the Office has summarily dismissed the limitation, declaring it a "mere matter of design choice." Applicant respectfully submits that, contrary to the Office's unfounded position, providing "first and second radiation detectors disposed at opposite ends of the capsule" is not a merely trivial matter of design choice. In particular, Applicant notes that such positioning of detectors provides a directional response that is largely insensitive to broad background sources. See paragraph [0079] of Applicant's original specification. To the extent that the Office believes that such advantages were recognized in the prior art, or that such results are expected, Applicant requests the Office to provide specific citations to

10/713,637  
END5240USNP

prior art passages or other actual evidence to support such a position. Otherwise, Applicant maintains that the combined art of record fails to teach or suggest all of the limitations of claim 1 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 1 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 11 recites "a substance for associating with cancerous tissue, wherein the detector is operable to detect cancerous tissue by detecting the substance associated with cancerous tissue." These limitations, among others recited in amended claim 11, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of amended claim 11 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 11 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 12 recites "determining whether cancerous tissue is present in the gastrointestinal tract of the patient." These limitations, among others recited in amended claim 12, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of amended claim 12 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 12 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 28 recites "providing a display, wherein the display indicates the detection of the target tissue type as detected by the detector in relation to the associated position of the detector within the patient's gastrointestinal tract." These limitations, among others recited in amended claim 28, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of amended claim 28 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to

10/713,637  
END5240USNP

render present claim 28 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Even if all of the references in combination taught or suggested all of the limitations recited in the amended claims, the Office has failed to establish the motivation to modify or combine the teachings of the references as required by MPEP 2143, and has instead relied upon impermissible hindsight reconstruction in declaring the claimed invention obvious. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembicza*k, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements* regarding the teaching of references, standing alone, simply *are not evidence*. *Id.* Rather than being based in evidence in the record, the motivation provided by the Office appears to be based solely on a subjective opinion of an individual examiner rendered nearly 5 years after the priority/filing date of the present application. This falls far short of the requirements of MPEP 2143.01. See *In re Dembicza*k, 50 USPQ2d 1614 (Fed.Cir. 1999). Ultimately, the Office has failed to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

#### Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims that are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and

10/713,637  
END5240USNP

preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

Andrew B. Ulmer/  
Andrew B. Ulmer  
Reg. No. 57,003  
Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(513) 337-3535